

REMARKS

The Examiner's action in withdrawing the double patenting rejection over U.S. Patent 5,372,907 is acknowledged with appreciation.

Claim 1 has been extensively amended herein in an effort to more clearly and adequately define the invention. Support for the amendment is provided by the disclosure from line 32, page 5 to line 27, page 7 of the specification.

The rejection of claims 1-27 under 35 U.S.C. 103 as unpatentable over Garth in view of Stahlhofen and Newman is again respectfully traversed.

As pointed out in the Request For Reconsideration dated May 17, 1995, Garth provides no disclosure of the use of two of the four essential ingredients of Applicants' novel composition, namely the haloalkyl-substituted S-triazine and the infrared absorber. The Examiner again refers to the Crystal Violet SC, utilized in Examples 2 and 3 of Garth, as "an infrared absorber." However, Attorney for Applicants has provided the Examiner with copies of both U.S. Patent 4,034,183 and pages 239 and 240 from "The Sigma-Aldrich Handbook of Stains, Dyes and Indicators" which demonstrate that Crystal Violet SC is not an infrared absorber. Crystal Violet SC is described as having almost no absorption above 650 nanometers whereas the infrared region is above 770 nanometers. Thus, Crystal Violet SC is not an infrared absorber. The Examiner has apparently totally ignored the documents which Attorney for Applicants has provided and has merely repeated the incorrect statement that Crystal Violet SC is an infrared absorber. This is clearly reversible error on the part of the Examiner. An Examiner must consider all evidence submitted on behalf of an applicant for patent and must respond to all arguments submitted by Applicant's attorney. The attention of the Examiner is courteously directed to Section 707.07(f) of the Manual

of Patent Examining Procedure and especially to the following quote from this section:

"Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

The Examiner has not only failed to answer the substance of the arguments in the Request For Reconsideration dated May 17, 1995, but appears to have totally ignored them.

Garth has no reason to use an infrared absorber since he exposes with ultraviolet radiation and not infrared radiation. While Garth does not explicitly state the reason for which he uses Crystal Violet SC, this material is a colorant that is commonly used to enhance the sensitivity of orthoquinone diazide compositions to ultraviolet radiation and Garth apparently uses it in very small amounts in his working examples 2 and 3 for this purpose.

It is noted that the Examiner has taken an inconsistent position in this case with regard to Garth compared to the position which she took in related application Serial No. 298,472, filed August 19, 1994. Application Serial No. 298,472 was allowed on May 30, 1995 and in the Reasons For Allowance the Examiner makes the following statement: "Garth does not teach the claimed latent Bronsted acid, the infrared absorber and the terephthalaldehyde." (underlining added). Thus, in the present case the Examiner's allegation that Garth teaches the use of an infrared absorber is in direct contradiction with her conclusion in Serial No. 298,472 that Garth does not teach the use of an infrared absorber. It should not be too much to expect an Examiner to take consistent positions in related cases being handled by that Examiner.

Since Garth provides no disclosure of the use of two of the four essential ingredients of Applicants' novel composition, namely the haloalkyl-substituted S-

triazine and the infrared absorber, it provides no basis for rejecting any of Applicants' claims and this is the case even when Garth is combined with Stahlhofen and Newman.

The Request For Reconsideration dated May 17, 1995, summarized the teachings of Stahlhofen and pointed out that the Examiner had overlooked the fact that Stahlhofen employs sulfonyl halides of naphthoquinonediazides whereas Garth does not employ his naphthoquinonediazide in the form of a sulfonyl halide. Once again, the Examiner has totally ignored the argument provided by Attorney for Applicants and merely repeated the prior rejection.

Stahlhofen requires that the naphthoquinonediazide compound be an organic halogen compound so that it will form a halogen acid. Garth does not require the formation of a halogen acid but, on the contrary, uses his naphthoquinonediazide to provide sensitivity to light. Thus, Stahlhofen provides no conceivable basis on which one would be lead to replace the naphthoquinonediazide of Garth with a haloalkyl-substituted S-triazine. Note that Stahlhofen teaches the optional use of a 1,2-quinonediazide as the component (a) of his formulation which imparts the light sensitivity. Thus, he can use both a 1,2-quinonediazide and a naphthoquinone-diazidosulfonyl halide in the same composition. He does not disclose any equivalence between his 1,2-quinonediazide and his haloalkyl-substituted S-triazine.

Since Stahlhofen discloses only one of the four essential components of Applicants' novel composition, namely the haloalkyl-substituted S-triazine, it provides no basis for rejecting Applicants' claims whether it is considered alone or in combination with Garth.

The Request For Reconsideration dated May 17, 1995, summarized the teachings of Newman and pointed out that Newman provides no disclosure of Applicants'

use of a mixture of a resole resin and a novolac resin nor of Applicants use of a haloalkyl-substituted S-triazine. Once again, the Examiner has totally ignored the argument provided by Attorney for Applicants and merely repeated the prior rejection.

With regard to the materials used for preparation of resole resins and novolac resins, Applicants do not base their case for patentability on the use of particular starting materials but on the use of the products in admixture and together with the other necessary components of the novel four-component formulation. Particularly good results in Applicants' novel four-component composition are achieved when the resole resin is derived from bis-phenol A and formaldehyde and the novolac resin is derived from m-cresol and formaldehyde. This is in no way disclosed or suggested by Newman.

Combining either or both of Stahlhofen and Newman with Garth can in no conceivable way suggest or render obvious Applicants' novel four-component composition. No reason exists to pick particular ingredients out of the formulation of Stahlhofen or the formulation of Newman and substitute them into the formulation of Garth. To combine references there must be appropriate motivation and none exists in this case. Moreover, it is not reasonable to arbitrarily pick and choose portions of a reference such as Stahlhofen or Newman while ignoring the totality of its teachings.

Applicants have now amended claim 1 to emphasize the benefits of their invention and help to distinguish it over the prior art. The Examiner is respectfully asked to reconsider the amended claim.

None of the three references describes a composition that has the advantageous characteristics of Applicants' composition. Applicants' composition is useful to produce a printing plate which can be employed as either a positive-working plate or a negative-working plate. This is in no way the objective of Stahlhofen's invention. It is the


objective of both Garth and Newman but in both instances the plates described require two exposure steps in order to be utilized as a negative-working plate, namely an imagewise exposure and a subsequent overall exposure. This serious disadvantage is completely avoided by Applicants' invention.

The attention of the Examiner is courteously directed to the disclosure from line 5, page 3 to line 29, page 5 of Applicants' specification which describes the deficiencies of both Garth and Newman and explains the advantages and benefits of the present invention.

It is believed that upon reconsidering this case in light of the detailed arguments presented in the Request For Reconsideration dated May 17, 1995, in light of the amendments of claim 1 made herein, and in light of the above remarks, the Examiner will recognize that Applicants have made an important contribution to the art which fully entitles them to the grant of a patent.

This case is now believed to be in condition for allowance. The Examiner is respectfully asked to reconsider and to pass the case to issue.

Respectfully submitted,


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